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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,053	06/07/2001	Kimberly Patrick Farrow	7099-1461	6053

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/875,053

Applicant(s)
Farrow et al.

Examiner
Cuong H. Nguyen

Art Unit
3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/02/2002 (Request for withdrawal of attorney).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

DETAILED ACTION

1. This Office Action is the answer to the communication received on 12/02/2002, which paper has been placed of record in the file.
2. Claims **1-14** are pending in this application.

Drawings

3. This application has been filed with drawings which are acceptable for examination purposes.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims **1-14** are rejected under 35 U.S.C. § 102(b) as being anticipate by **Godin** et al. (US Pat. 5,890,138).

A. Re. To claim 1: **Godin** et al. suggest that in a network comprised of a client device and at least two server devices, a method for providing real-time price information upon request (see **Godin** et al., Fig.1), the method comprising:

- receiving, at a first server device from a user/client device, a request for content (see **Godin** et al., Fig.1, ref. 12 or ref. 10);
- providing, by a first server to a user/client device (see **Godin** et al., Fig.1. ref. 10 or ref.12), the requested content; and

- providing a client device updates to data referenced in the content, wherein the data is subject to update by the second server (i.e., mail server) (see **Godin et al.**, Fig.1, ref. 34).

B. Re. To claim 2: **Godin et al.** suggest about a selection/determination from a client device and a first web server whether the content refers to data that is subject to modification by a second server i.e., an email for changing shipment/price .etc. (see **Godin et al.**, Fig.1, ref. 34).

C. Re. To claim 3: **Godin et al.** suggest that transmitting code from a first server to a user/client, wherein code executing on a user/client device establishes a communication link with a second server to receive any updates to data referenced in the content (see **Godin et al.**, Fig.1-ref. 34, and Fig.3-ref.128).

D. Re. To claim 4: **Godin et al.** suggest that transmitting code from a first server to a user/client device, wherein the code executing on a user/client device generates updates to data based on detected conditions (see **Godin et al.**, Fig.1-ref. 34, and Fig.3-ref.128).

E. Re. To claim 5: **Godin et al.** disclose that providing, by a second server (mail server), an interface with a purchasing service e.g., a user is provided by a mail server access to computer 32, bank system 28 and database server 22 .etc. (see **Godin et al.**, Fig.1-ref. 34).

F. Re. To claim 6: **Godin et al.** disclose that providing variable data that has been narrowcasted i.e., a "final price" for an item is provided to a user by a mail server (see **Godin et al.**, Fig.1-ref. 34).

G. Re. To claims 7, 11, and 12: They contain similar features as claimed in claim 1; therefore, similar rationales and reference are applied for rejections under 35 USC 102(b).

H. Re. To claim 8: It contains a similar feature as claimed in claim 3; therefore, similar rationales and reference are applied for a rejection under 35 USC 102(b).

I. Re. To claim 9: It contains a similar feature as claimed in claim 5; therefore, similar rationales and reference are applied for rejections under 35 USC 102(b).

J. Re. To claim 10: It contains a similar feature as claimed in claim 6; therefore, similar rationales and reference are applied for rejections under 35 USC 102(b).

K. Re. To claim 13: **Godin** et al. inherently suggest a system for displaying real-time product information, comprising:

- a memory having instructions; and
- a processor responsive to the instructions to: receive a request for variable data (i.e., auction prices that going to be changed time after time) and code, respond to the request for data and code, receive requests for updates, and to respond to requests for updates to those data.

The examiner submits that **Godin** et al.'s patent provide a system with claimed components (see **Godin** et al., Figs.1-3). Please note that applicants are claiming a 'system' in claims 13-14, any claiming of functional language should then be limited to a system, machine, product, or apparatus as to opposed to a process or method.

Because system claims cover the structure of the machine. A "use" can only be claimed by claiming the use as a process. See *In re Papesch*, 315 F.2d

381, 384, 137 USPQ 1084, 1088 (CCPA 1963). Claims directed to a system must be distinguished from the prior art in terms of structure rather than function.

See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the prior art is capable of performing the claimed function "even if not directly disclosed" it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (Applicant's popcorn dispenser was rejected with an oil can because the functional limitations were inherent in the reference). It is the Examiner's position that the cited prior art computer is capable of performing the claimed functions (i.e. the computer is capable of updating a product for price, shipping, method of charges .etc.).

L. The Examiner submits that claims **13-14** are directed to a system, but they comprise many functional language (such as claimed phrases after the word "responsive to the program instructions to...") instead of defining about components, modules .etc. An example may be of use: A claim reciting "A glove for catching a baseball" is very different in scope than a claim reciting "A glove catching a baseball." The first claim recites a glove and how the glove is used. The second claim actually claims the catching of a ball. An interpretation that the two claims are essentially the same would fail to give any patentable weight to the word "for" and would therefore be improper. Whether its "for" or "to", the words generally denote how the antecedent is used or what it is used for.

M. Re. To claim 14: It contains a similar feature as claimed in claim 13; therefore, similar rationales and reference are applied for rejections under 35 USC 102(b).

Conclusion

8. Claims **1-14** are not patentable.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone number is 703-305-4553. The examiner can normally be reached on Mon.-Fri. from 7:00 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

703-746-5572 (RightFax) Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA, 7th floor receptionist.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Cuonghnguyen
Primary Examiner